REMARKS

A. SECTION 103(A) REJECTIONS

Claims 1, 2, 6, 7, 44, 49, 56 and 57 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Cole (U.S. Patent No. 5,850,217), and further in view of Schreadley (U.S. Patent No. 5,887,903) and in further view of Wilson ("Restaurants Offering Own Tips On How Much To Give Waiter").

Claims 3-5, 8-43, 45-48, 50-55 and 58 stand rejected as being unpatentable over Cole and in view of Schreadley and further in view of Wilson and further in view of Schulze (U.S. Patent No. 6,233,564).

Applicants respectfully traverse the Examiner's Section 103(a) rejections.

1. Claims 2-5

Claims 3-5 depend from independent Claim 2. Accordingly, the arguments provided with respect to Claim 2 are equally applicable to Claims 3-5.

The Office Action acknowledges that neither Cole nor Schreadley teaches "providing an offer." Applicants submit that neither Cole nor Schreadley teaches or suggests

> determining an offer based on the received request
>
> transmitting the offer for output to the customer on a record of charge
>
> receiving an acceptance of the offer by the customer on the record of charge
>
> providing a benefit to the customer after receiving the acceptance

as recited in independent Claim 2.

The Office Action includes a finding that

> Wilson teaches providing an offer that allows customers to check a box for the desired tip, thereby outputting on the record of charge an indication of acceptance (See Full Text). This provides a benefit to the customer in that the tip is paid without the customer having to perform the calculation.

[Office Action, page 3]. Applicants agree that Wilson teaches calculating one or more "gratuity guidelines" or suggested tips, and including such calculated tips on a check. As a result of putting the calculated tip on the check, Wilson, however, cannot suggest indicating the amount of a calculated tip after receiving the acceptance of the offer that is on the record of charge (which the Examiner asserts is the opportunity to receive the indication of the pre-calculated tip).

If, on the other hand, the Examiner is making a finding that Wilson teaches calculating a total (including a suggested tip amount) "without the customer having to perform the calculation," Applicants respectfully disagree. Wilson is silent as to how any total amount is calculated, or who calculates it, if a customer selects a particular suggested tip. Wilson states:

> At Lula in Santa Monica, for instance, checks come with a recommended tip of 15%, 18% or 20% of the meal's cost. Customers, properly encouraged, can then check a box, once they get over the surprise.

Applicants note that the New York Times article cited by the Examiner also makes a reference to the practice at Lula, but does not mention the "check a box" process and is similarly devoid of any hint of how a total bill is calculated (or who calculates it).

Applicants also note that it is not inherent in Wilson that a total amount that included a selected tip is calculated for the customer. It is not necessary that such a calculation be made for the customer. The customer, for example, could check a box to indicate a particular tip and still be required to calculate the total himself.

Accordingly, the asserted combination of Cole, Schreadley, and Wilson does not teach at least the feature of *providing a benefit to the customer after receiving the acceptance*. The Schulze reference does not correct this deficiency of the proposed combination of references.

Claim 2 also includes the feature of: *in which the offer defines an obligation for the customer to fulfill in exchange for the benefit*.

With respect to Claim 2, the Office Action makes a finding:

> Wilson teaches that the offer defines an obligation for the customer to fulfill in exchange for the benefit (See full text: Customer must pay more as an obligation).

Applicants respectfully disagree with this finding. Applicants respectfully submit that the asserted finding indicates the subject matter of Claim 2 was misconstrued and/or the subject matter was not considered as a whole.

Applicants accept that, generally, paying more may be interpreted as an "obligation." The Office Action, however, also asserts that the offer of Wilson "allows customers to check a box for the desired tip," and the benefit of Wilson is specifically that "the tip is paid without the customer having to perform the calculation."

In stating that Wilson teaches the above specific feature of Claim 2, the Office Action therefore must be asserting that Wilson teaches: in which allowing a

customer to check a box for a desired tip [the alleged *offer*] defines paying the tip [the alleged *obligation for the customer*] is in exchange for paying the tip (or paying the tip without having to perform the calculation) [the alleged *benefit*].

Applicants respectfully traverse this analysis. To the extent that the finding requires an interpretation of Wilson that the obligation and the benefit being identical (paying the tip), the finding is improper and cannot support a finding of obviousness of Claim 2. It would defy logic and common sense to suggest that any offer would require its obligation to be the same as its benefit. Wilson does not suggest defining an obligation for a customer to pay a tip in order to receive the benefit of paying the tip.

The Final Office Action, however, explicitly makes a finding that the "benefit" of Wilson is the pre-calculation of the tip, and the "obligation" is the paying of the tip. That finding is erroneous and not supported by Wilson. The tip is calculated and included on the check without any corresponding obligation of the customer, and, in any event, the pre-calculated tip (the alleged benefit) is indicated prior to when the customer would pay the tip (the alleged obligation). Accordingly, the alleged benefit precedes any acceptance of the alleged offer, per the Examiner's own analysis.

To the extent the finding relies on an interpretation that Wilson teaches paying a tip is an obligation to fulfill in exchange for not having to calculate the total bill, Applicants noted above that Wilson does not teach that customers do not have to calculate the total bill. But even if Wilson did so teach, it defies logic that if "paying more" or paying a tip would suggest an obligation to fulfill, the corresponding benefit would be not having to calculate a total bill. For instance, the customer presumably would receive the same benefit (calculating the total) without paying any tip, and would receive the same benefit (calculating the total) regardless of how much he or she tipped. Nothing in Wilson remotely suggests that paying a tip is defined in an offer as an obligation to fulfill to receive a benefit of paying that tip without having to calculate the total bill.

For at least the above reasons, Applicants respectfully submit that no prima facie case of obviousness has been provided for any of Claims 2-5. However, Claims 3 and 5 have been cancelled without prejudice by this Amendment and their rejection is moot.

Further, Claim 2 has been amended in order to provide for a particular embodiment in which the offer output on the record of charge is selected from the group consisting of a supplemental product offer and a cross-subsidy offer. The cited combination of references does not provide for all of the subject matter of

Claims 2 and 4. Claim 4 provides specifically for wherein the offer is a cross-subsidy offer.

2. Claims 6-58

Claims 17-20, 29, 45-48 and 56-58 have been cancelled without prejudice by this Amendment.

Each of independent Claims 6, 44 and 51 has been amended and similarly provides for embodiments in which the offer output on the record of charge is selected from the group consisting of a supplemental product offer and a cross-subsidy offer, as discussed above with respect to Claim 2 above. Applicants respectfully submit that Claims 6-16, 21-28, 30-44 and 49-55 contain allowable subject matter and the Examiner's reconsideration of those claims is kindly requested.

Further, with respect to Claim 55, the specific recited feature of *wherein the record of charge contains separate signature lines for the purchase amount and the offer* is not addressed in the Office Action. Nothing in the cited references remotely suggests such a feature. Various embodiments described in the Specification provide advantageously for multiple signature lines on a single record of charge, in which each corresponds, for example, to a different amount (e.g., one for a first amount to be charged if the offer is not taken, and one for a different amount to be charged and/or commitment to an obligation if the offer is taken).

For at least these reasons, Applicants respectfully submit that no prima facie case obviousness has been established for any of Claims 51-55. Applicants respectfully request the Examiner's reconsideration and withdrawal of the Section 103(a) rejections of Claims 6-16, 21-28, 30-44 and 49-55.

B. ADDITIONAL COMMENTS

Our silence with respect to the Examiner's other various assertions not explicitly addressed in this paper, including assertions of what the cited reference(s) teach or suggest, the Examiner's interpretation of claimed subject matter or the Specification, or the propriety of any asserted combination(s) of teachings, is not to be understood as agreement with the Examiner. As the Examiner has not established an unrebuttable prima facie case for rejecting any of the claims as pending, for at least the reasons stated in this paper, we need not address all of the Examiner's assertions at this time. Also, the absence of arguments for patentability other than those presented in this paper should not be construed as either a disclaimer of such arguments or as an indication that such arguments are not believed to be meritorious.

C. NEW CLAIMS 59-63 CONTAIN ALLOWABLE SUBJECT MATTER

New Claims 59-63 provide generally for embodiments in which a record of charge includes two signature lines, one for accepting the purchase amount and one for accepting the offer output on the record of charge. No combination of the cited references teaches of suggests such subject matter. Accordingly, Applicants submit that new Claims 59-63 are allowable over the cited references.

D. PETITION FOR EXTENSION OF TIME TO RESPOND & AUTHORIZATION TO CHARGE APPROPRIATE FEES

Applicants understand that a five-month extension of time to respond to the Office Action is necessary.

Please grant a petition for any extension of time required to make this Response timely. Please also charge any other appropriate fees set forth in 37 C.F.R. §§ 1.16 – 1.18 for this paper and for any accompanying papers to:

Charge:	$2350.00
Deposit Account:	50-0271
Order No.:	99-012

Please credit any overpayment to the same account.

E. CONCLUSION

It is submitted that all of the claims are in condition for allowance. The Examiner's consideration is respectfully requested.

If the Examiner has any questions regarding this paper or the present application, the Examiner is cordially requested to contact Michael Downs at telephone number (203) 461-7292 or via electronic mail at mdowns@walkerdigital.com.

Respectfully submitted,

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Date

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